

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:)
P.C. Blank et al)
) Art Unit: 1772
)
Application No.: 10/804,953)
Confirmation No: 8082) Examiner: Nordmeyer, P.
)
Filed: 03/19/2004)

Title: Columnar Adhesive Label Roll

PETITION UNDER 37 CFR 41.3

Mail Stop Petition
Attn: Chief Administrative Patent Judge
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the office action dated 02/23/2007 entitled "Notification of Non-Compliant Appeal Brief," Applicants hereby petition under 37 CFR 41.3 (MPEP1205.03) seeking supervisory review of the objection to the appeal brief for non-compliance.

On 3/19/2007 the undersigned attorney conducted a phone call with examiners Nordmeyer and Ahmad regarding the several objections.

As best this attorney understands from the phone call, the examiners have received oral directions from an appeal conferee, identified as Jennifer Kolb Michener, for the basis to object to the brief, without identification of any specific rule, MPEP provision, or other legal support for the objections, and notwithstanding this attorney's interpretation of the applicable provisions.

Apparently, the examiners are constrained by the appeal conferee to enter and sustain the objections; and these objections are now being petitioned as clear error, and without due support in applicable legal provisions.

The office action has boxes 1, 4, 6, and 10 checked.

Box 1 states that the brief does not contain the items required under Board Rule 37(c).

Continuation Box 10 explains this objection as based on the inclusion of the "Background" section at page 6 of the brief; and further states that the "appeal brief may only contain the headings listed under 37 CFR 41.37."

Apparently, the appeal conferee has mandated that the ten Brief headings (i - x) are exclusive, and not inclusive.

Applicants Brief contains all ten headings in the stated order, and is therefore compliant with Board Rule 37, and the examiner has not shown otherwise.

The examiner has not cited any language in Board Rule 37 that excludes any additional headings or items, including Applicants' Background heading and section.

Accordingly, Applicants request supervisory review of this ground of objection, and the withdrawal thereof; and further that MPEP ch. 1200, or some other provision, be amended to specifically address this issue and expressly state whether or not the ten items are exclusive or inclusive.

Box 4 states that the brief does not contain a "concise explanation of the subject matter defined in each of the independent claims."

Box 10 explains that the last three paragraphs on page 8 of the brief "are not directed towards the subject matter defined in the independent claims"

However, the Summary section indeed presents the requisite concise explanation of expressly listed independent claims 1, 19, and 31.

The two penultimate paragraphs at page 8 indeed expressly describe the independent claims previously described, and the last paragraph introduces the nexus between the independent claims and their dependent claims.

Clearly, even the last three paragraphs, which collectively are only three sentences long are indeed "concise," and should not

have been objected to.

Board Rule 37(c)(1)(v) states only the mandatory requirements, and those requirements have been clearly presented in the original summary section.

Board Rule 37(c)(1)(v) does not provide any support for the examiner's bald contention of extraneous matter.

And, indeed, the Federal Register, Vol. 69, No. 155, in which the new appeal rules were presented as final, contains at page 49976, comment 53 expressly explaining the concise explanation provision.

That comment does not give the examiner license to object to Applicants' prerogative of presenting the concise explanation, as Applicants sees fit.

Indeed, to the contrary, comment 53 expressly states that "Appellant may include any other information of record which will aid the Board in considering the subject matter of each independent claim."

It would therefore appear that the examiner has exceeded her authority and discretion in objecting to Applicants' summary section under Board Rule 37(c)(1)(v), and the objection should be withdrawn.

And, it would also appear warranted that the MPEP be amended to expressly address this issue and provide clear written guidelines for examiners and practioners on the permitted scope of the concise requirement under Board Rule 37(c)(1)(v).

Box 6 states that the "brief does not present an argument under a separate heading for each ground of rejection on appeal;" and Box 10 explains that no "subheading" is provided for any claim argued separately, and that the "MPEP 706.02(j)" "subheading" presented at page 16 of the brief is improper as not being directed "to either a claim being argued individual or a single ground of rejection."

This again, is clear error.

Board Rule 37(c)(1)(vii) requires a heading for each ground

of rejection.

There are four grounds of rejection initially listed at page 9 of the brief.

And, corresponding headings in compliance with this rule are found at pages 10, 40, 45, and 52 for these four grounds, respectively.

Accordingly, the brief meets Board Rule 37(c)(1)(vii).

This rule, however, allows a "subheading" for separately argued claims, but this is not mandatory. MPEP 1205.02 expressly states that such subheadings are "optional."

Pages 49962 & 49963 of the Federal Register implementation of the final rule also expressly state that the subheadings are "optional."

The examiner's objection to the brief for failing to contain those optional subheadings is therefore unwarranted, and an abuse of prosecution.

Since the MPEP already appears clear on this issue, then the oral (?) "guidelines" being invoked by the appeal conferee should be addressed, and proper supervisory review thereof is warranted to investigate and conform that practice with the Board Rules and the MPEP, and prevent further abuse thereof.

As for the objected-to MPEP 706.02(j) "subheading" presented at page 16 of the brief, the examiner has not cited any authority in Board Rule 37(c)(1)(vii) that bars any additional subheading that any applicant may choose to introduce for the benefits of clarity of the brief and to "aid the Board."

It appears that the examiner is acting outside the express Board Rules and applicable MPEP provisions by entering the present objections under the "guidelines" proffered by the appeal conferee.

If such inflexible "guidelines" are indeed being proffered by any appeal conferee, or by any other PTO agent involved in the appeal process, then those guidelines should be of record for patent practitioners to review and evaluate; and those guidelines

must conform with the applicable patent statutes, rules, and MPEP provisions.

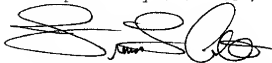
The appeal process is difficult enough as presently mandated by the known, applicable rules, and to introduce any "hidden" rules or hidden practices outside the scope of those rules is unwarranted, and should be fully investigated.

For these exemplary reasons, withdrawal of all pending objections to the originally filed appeal brief is warranted and requested.

And furthermore, proper supervisory review and investigation of any appeal conferee "guidelines," in whatever form they exist, is also warranted and requested to ensure that the present Applicants, as well as all applicants, receive the due process of law and examination to which they are entitled.

Since this Petition is being made under Board Rule 41.3 for supervisory review, no fee is believed required. However, if the \$130 petition fee under Board Rule 41.20(a) is deemed necessary, please charge the required fee to Deposit Account No. 14-0225 of NCR Corporation.

Respectfully submitted,



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Date: 19 MAR 2007

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